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Election #5
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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

TAKASHI KATO, ET AL.

Appln. No.: 09/362,698

Filed: July 29, 1999

For: OPTICAL SYSTEM AND
OPTICAL INSTRUMENT WITH
DIFFRACTIVE OPTICAL
ELEMENT

Examiner: J. Winstedt

Group Art Unit: 2872

February 28, 2001

The Commissioner for Patents
Washington, D.C. 20231

RESPONSE TO ELECTION OF SPECIES REQUIREMENT

Sir:

Applicants respectfully traverse the election of species requirement set forth in the Office Action dated January 31, 2001.

In the Office Action, the Examiner requires Applicants to elect between two species of the invention. As asserted by the Examiner, species I is found in claims 4 and

5, while species II is found in claims 6 through 11, 13, 15 and 17.

Applicants respectfully submit that the premise of the Examiner's requirement is flawed, since claims are never species (see M.P.E.P. § 806.04(e)). Accordingly, Applicants request reconsideration and withdrawal of the election of species requirement on this basis.

In addition, a careful review of the subject application reveals that the various embodiments are so closely related as to not require separate fields of search. Accordingly, neither Applicants nor the Patent and Trademark Office should be put through the trouble and expense entailed in multiple filing and prosecution. Moreover, Applicants submit that the public-at-large should not be required to obtain and study several patents in order to have available all of the issued patent claims covering the subject invention.

Further, the making of an election of species is not mandatory in all instances where it is possible to do so. Rather, the Examiner may use his or her discretion and choose not to make an election of species where circumstances

warrant. It is believed that such is the case in the subject application. Therefore, Applicants request, under 37 CFR 1.143, that the Examiner reconsider and withdraw the election requirement set forth in the above-noted Office Action for these reasons as well.


Nevertheless, pursuant to the provisions of 37 CFR 1.146 and M.P.E.P. § 809.02(a), Applicants provisionally elect, with traverse, to prosecute the species represented by the embodiments of Figures 3, 8A and 8B. Applicants submit that claims 1 through 5, 12, 14 and 16 read on the elected species. Also, as noted by the Examiner, claims 1 through 3, 12, 14 and 16 have been deemed to be generic.

Applicants submit that the instant application is in condition for allowance. Favorable consideration and an early passage to issue are requested.

Applicants' undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010.

All correspondence should be directed to our address listed below.

Respectfully submitted,



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